



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,300	07/19/2001	Jiro Onishi	CU-2599 WDD	1834

7590

04/28/2004

Ladas & Parry  
Suite 1200  
224 South Michigan Avenue  
Chicago, IL 60604

EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
----------	--------------

1771

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- ☒ Responsive to communication(s) filed on 2/12/04
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- ☒ Claim(s) 6-20 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 6, 15, 17, 18, 20 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

### Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit 1771

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 6, 15, 17, 18 and 20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, quite a few problems still remain with the claims and while the Examiner will try to point out as many informalities as he can, applicants should be aware that other such informalities may not have been noticed and should be corrected. In claim 6, lines 1-2, the language in an article claim of "used for" is improper, and also "transferring a transferring" seems unduly informal. In line 7, the phrase "adhesive property suitable for the receptor layer . . ." is vague and indefinite with respect to what constitutes "suitable for"; also, "arranged at a farthest portion from the substrate sheet" is unduly vague and indefinite with respect to location. In line 11 it is suggested to put "Bec's" before "smoothness" and delete the following recitation of the parameter as being redundant. This also occurs in claim 18. In claim 6, the phrase "and arranged at a closest portion from the substrate sheet" and following thereafter "adhere firmly" are each vague and indefinite with respect to the parameter being claimed. In claim 15, line 6, it is unclear whether the phrase

Art Unit 1771

"and the transferring adhesive layer" is part of the Markush grouping, or if not, how it is integrated into the claimed structure. Additionally, the phrase later on found twice in the claim "is formed as the plane, shape and size to fit an individual image forming area" is vague and indefinite. In claim 17, the phrase "has a smaller area than an area of the transferring adhesive layer" is vague and indefinite with respect to the claimed relationship. In claim 18, lines 1 and 6, "comprises" should be --comprising-- and the phrase "formed by the different material from a material of the uppermost layer" is vague and indefinite, i.e., as was earlier stated "different material" reads on just about anything.

3. The following is a quotation of the first paragraph of 35 U.S.C. § 112:  
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 6, 15 and 17 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s),

at the time the application was filed, had possession of the claimed invention. More particularly, in independent claim 6 (but not independent claim 18) the phrase "formed of a resin other than ionomer" appears to be new matter since it is believed to fall under the rule of Ex parte Grasselli et al. Board of Appeals 231 U.S.P.Q. 393 affirmed CAFC 738 F. 2d 453 (Fed. Cir. 1984) to the effect that limitations such as "free of" a certain element are new matter in the absence of an express disclosure, which is not believed to be set forth in applicants' lengthy specification, and it is noted that no express support has been pointed out by applicants in their response.

5. Claims 6, 15, 17, 18 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over EP -077, substantially for reasons of record, together with the following additional observations. Initially it is noted that EP -077 clearly teaches at page 4, lines 35-37 that in a preferred embodiment the adhesive layer can be a laminate of two or more adhesive layers which clearly sets forth the basic three layer adhesive sandwich structure found in each of applicants' "transferring adhesive layer" structures in each of the independent claims. It is also again noted that page 6, lines 21-30 of the reference sets forth a large number of materials suitable for forming the adhesive layer or layers in the reference structure, and can include

"ionomers" (line 27) which would therefore read upon or render obvious the claimed language utilized by applicants that various layers may be "other than ionomer" or be formed from an ionomer resin. With respect to the Bec's smoothness parameter, this is again believed to be an inherent property, in the absence of unexpected results which heretofore have not been set forth on the record.

With respect to applicants' remarks, the Examiner must accordingly take direct issue with applicants' statement (Response, page 6, lines 5-9) that "there is no reference to the intermediate layer disclosed between the divided adhesive layers made in the specification of EP -077". As has been set forth above, this adhesive layer can be a laminate of two or more consecutive adhesive layers, and it is noted, e.g. applicants' claim 6, that in the last three lines that the "intermediate layer formed of a material having an adhesive property to adhere firmly to both the uppermost layer and the basement layer and arranged between the uppermost layer and the basement layer" clearly reads upon the presence of such a third adhesive layer.

Additionally, with respect to applicants' arguments (Response, page 6, second complete paragraph) regarding the "blurring of an image" alleged property, this has yet to be proven by a suitable comparison and note also that many of the suitable resins, i.e.,

Art Unit 1771

layers taught by the reference, meet the glass transition temperature set forth for the uppermost layer in applicants' claims. In summary, applicants have failed to rebut the prima facie case of record.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Serial No. 09/909,300

-7-

Art Unit 1771

Dzirker:cdc

April 21, 2004

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1300  
1700

*Daniel Zinker*